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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/068,232 | 02/06/2002 | Aude Prieur-Blanc | ESSR:062US | 8542 |

7590

10/03/2005

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| EXAMINER |
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VARGOT, MATHIEU D

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| ART UNIT | PAPER NUMBER |
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1732

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/068,232 | Applicant(s) PRIEUR-BLANC ET AL. | |
| | Examiner Mathieu D. Vargot | Art Unit 1732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1732

1. Claims 18-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 18 to recite that the fine grinding and/or polishing constitutes attacking with a solvent **but not with a non-solvent**. However, there is no support for this recitation. Applicant specifically notes page 2, lines 20-21 in the instant specification as providing support for this limitation. However, this disclosure to a non-solvent is merely a discussion of the prior art to Duchane et al in US Patent 4,376,751, which is applied as a secondary reference against the claims. Unless applicant can show somewhere else in the specification where "without a non-solvent" is specifically taught as an embodiment of the instant invention, it is respectfully submitted that the instant amendment introduces new matter which was not disclosed in the original specification. Negative limitations require clear support in the specification. The fact that applicant's specification contains a disclosure of the limitation due to a discussion of the prior art is not sufficient to enable him to positively exclude same in the claims unless there is positive support for such.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth at page 1, line 7 through page 2, line 11 of the instant specification in view of Duchane et al (col. 1, lines 40-50; col. 2, lines 45-55) for reasons of record as set forth in the previous action.

It is noted that applicant has amended the claims to recite that the fine grinding and/or polishing is done without a non-solvent. At already noted in paragraph 1, it is submitted that this is new matter. Even if such is ultimately deemed not to be new matter, it is submitted that a fair reading of Duchane et al would show that the use of the non-solvent is what allows the treated surface to become super smooth. I.e., see column 3, line 50, wherein Duchane et al is discussing the super smooth surface at a magnification of up to 1600X. Whereas the prior art of Duchane et al which might only employ a solvent (as in the instant, allegedly) might not have perfectly smooth surfaces at this magnification, it is believed that one of ordinary skill in the art would understand from this disclosure that the surfaces treated with only a solvent would have macroscopically smooth surfaces. It is submitted that these macroscopically smooth surfaces would be the instant smooth surfaces.

3. Applicant's arguments filed July 27, 2005 have been fully considered but they are not persuasive. Applicant's comments are primarily directed to—1) the instant claiming of not using a non-solvent and 2) whether the art has been properly combined. Point one has already been addressed and it is believed that such constitutes new

Art Unit: 1732

matter. Applicant apparently believes that the mere disclosure of the terminology “non-solvent” when discussing what the prior art teaches—and possibly since the instant application does not expressly use a non-solvent—allows the introduction of the instant recitation. Contrary to this, negative limitations require clear support. In other words, the instant specification would have to state that no non-solvent is used in the invention, or at least for one particular embodiment. The mere failure to disclose any non-solvent is not evidence enough that applicant considered such to not be within the purview of the instant invention. Concerning the second point, it is respectfully submitted that one of ordinary skill in the art would have knowledge of solvent polishing techniques and would have used these in lieu of mechanical polishing.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1732

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
September 26, 2005


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

9/26/05